

REMARKS

Claims 1, 2, 4-26, 28-36 and 38-44 are all the claims pending in the application.

I. Information Disclosure Statement filed on May 13, 2004

Regarding the Information Disclosure Statement filed on May 13, 2004, Applicants again note that the Examiner did not consider the DE 44 33 868 reference submitted therewith because the Examiner asserted that an English translation was not provided. Applicants note, however, that a Search Report in the English language was submitted with the above-noted IDS which lists the DE 44 33 868 reference.

In this regard, Applicants note that MPEP §609(III)(A)(3) (Concise Explanation of Relevance for Non-English Language Information)(8th Edition) states the following with regard to references that are cited in an English language search report:

Where the information listed is not in the English language, but was cited in a search report or other action by a foreign patent office in a counterpart foreign application, the requirement for a concise explanation of relevance can be satisfied by submitting an English - language version of the search report or action which indicates the degree of relevance found by the foreign office.

Thus, because Applicants submitted a search report in the English language which cited the above-noted reference, Applicants submit that the concise explanation of relevance has been satisfied in accordance with MPEP § 609 A(3). Accordingly, Applicants respectfully request that the Examiner consider the above-noted reference and return an initialed and signed copy of the PTO-1449 form with the next Office paper.

If the Examiner does not believe that the above-noted reference should be considered on the merits, Applicants kindly request that the Examiner provide an explanation in this regard.

II. Objections to the Specification

The Examiner has objected to the specification as allegedly failing to provide proper antecedent basis for the subject matter recited in claim 19. Applicants note that claim 19 recites that when the data nullification device does not have a processing capacity sufficient to destroy all parts of the data block, the nullifying unit destroys only the part of the data block necessary to utilize the remaining parts of the data block.

Regarding this feature, Applicants note that the paragraph on page 15, lines 1-4 of the specification recites that “when the data nullification device does not have enough processing capacity, the nullifying unit may destroy only the part of the data block necessary to utilize the remaining parts of the data block”, and that the paragraph on page 40, lines 1-5 of the specification has been amended so as to recite that the “processing capacity judging unit judges whether the device 100 has sufficient processing capacity to destroy all parts of the data block which includes data relating to the digital content and is judged as needing to be nullified.”

Applicants respectfully submit that the above-noted paragraphs in the specification provide proper antecedent basis for the feature recited in claim 19, and note that the changes made to the specification are supported by the foreign priority document (Japanese application No. 2001-039140) for this application. In this regard, it is noted that the foreign priority was incorporated by reference into the present specification (see page 1 of the specification). Accordingly, the changes to the specification do not introduce new matter.

In view of the foregoing, Applicants kindly request that the objection to the specification be reconsidered and withdrawn.

III. Claim Objections

Claims 16-21, 33 and 43 were objected to as being of improper dependent form for failing to further limit their respective base claim. In particular, the Examiner asserted that the base claims required that the entire judged data block be overwritten with a new data block, while claims 16-21, 33 and 43 only require that a portion of the data block be overwritten.

By this amendment, Applicants note that claims 1, 25 and 35 have been amended so as to recite “to thereby nullify at least a part of the data block which is judged as needing to be nullified.”

In view of the foregoing, Applicants respectfully submit that claims 16-21, 33 and 43 further limit their respective base claim, and therefore, Applicants kindly request that the above-noted objection be reconsidered and withdrawn.

IV. Claim rejections under 35 U.S.C. § 112, first paragraph

Claims 19-21 have been rejected under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement. In particular, the Examiner has asserted that the subject matter set forth in claims 19-21 was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventors had possession of the claimed invention at the time the application was filed.

In particular, the Examiner asserts that the specification does not provide support for the feature in claim 19 which recites that “when said data nullification device does not have a processing capacity sufficient to destroy all parts of the data block, said nullifying unit destroys only the part of the data block necessary to utilize the remaining parts of the data block.”

For at least similar reasons as discussed above, Applicants respectfully submit that the paragraph on page 15, lines 1-4 of the specification, and the paragraph on page 40, line 1-5 of the specification, would reasonably convey to one skilled in the art that the inventors had possession of the claimed invention at the time the application was filed. As discussed above, it is noted that the changes to the specification are supported by the foreign priority document of the present application, and that the foreign priority document was incorporated by reference into the present specification (see page 1 of the specification). Accordingly, the changes to the specification do not introduce new matter.

In view of the foregoing, Applicants kindly request that the rejection under 35 U.S.C. § 112, first paragraph be reconsidered and withdrawn.

V. Claim Rejections under 35 U.S.C. § 103

The Examiner has rejected claims 1, 2, 4-8, 12-18, 25-28, 31-33, 35, 36 and 38 under 35 U.S.C. § 103(a) as being unpatentable over Matsushita (U.S. 6,694,022) in view of Yasukohchi et al. (U.S. 5,920,673).

Claim 1, as amended, recites the feature of a nullifying unit operable to, when a predetermined number of data blocks are judged as needing to be nullified or when one or more data blocks whose total amount of data reaches a predetermined amount are judged as needing to be nullified, write the new data block to a recording area, on the recording medium, that stores a data block which is judged as needing to be nullified, to thereby nullify at least a part of the data block which is judged as needing to be nullified and at the same time record the new data block. Applicants respectfully submit that the combination of Matsushita and Yasukohchi does not

teach or suggest at least this feature recited in claim 1.

Regarding the Matsushita reference, Applicants note that this reference discloses a digital broadcasting receiver which enables a user to view a “copy-disallowed” broadcast at a time later than when the broadcast is received, while satisfying the “copy-disallowance” condition of the broadcast (see col. 1, lines 62-67).

In particular, in Matsushita, it is described that when storing a digital broadcast that is not allowed to be copied, a “copy-disallowance” signal is stored along with the digital broadcast (see col. 7, lines 12-18). When the stored digital broadcast is subsequently read out, upon detecting the “copy-disallowance signal”, the digital broadcast is simultaneously erased by overwriting the broadcast data with “0” (see col. 7, lines 18-24 and col. 6, lines 51-54).

Regarding the Yasukohchi reference, as noted by the Examiner, this reference discloses a recording system in which data is continuously overwritten to thereby provide endless recording (see col. 3, lines 46-53).

In the Office Action, the Examiner has taken the position that based on the above-noted disclosure in Yasukohchi of endless recording, that one of ordinary skill in the art would have been motivated to modify Matsushita such that the digital broadcasting information thereof is continuously overwritten with newly received data. Applicants respectfully disagree.

In particular, as noted above, in Matsushita, when reading out and displaying a stored digital broadcast, it is possible for a user to view the broadcast information while maintaining the broadcast’s copyright protection by simultaneously overwriting the broadcast information with “0”. Thus, in Matsushita, the stored digital broadcast information is only overwritten when it is reproduced.

Accordingly, Applicants respectfully submit that if Matsushita was modified such that the stored broadcast information was continuously overwritten with newly received data, as suggested in the Office Action, that Matsushita's digital broadcasting receiver would be rendered inoperable for its intended purpose.

In other words, because the purpose of the digital broadcasting receiver of Matsushita is to permit a user to store and later view digital broadcast information while maintaining the copyright protection thereof, if the stored digital broadcast information was continuously overwritten with newly received data so as to provide endless recording, then the stored digital broadcast information could be overwritten before being viewed by the user.

In view of the foregoing, Applicants respectfully submit that because the modification to Matsushita proposed by the Examiner would render Matsushita's device inoperable for its intended purpose, Applicants respectfully submit that one of ordinary skill in the art would not have been motivated to combine Matsushita with Yasukohchi. As stated in MPEP § 2143.01, if a proposed modification would render the prior art being modified inoperable for its intended purpose, then there is no suggestion or motivation to make the proposed modification.

Furthermore, because the stored digital broadcast information of Matsushita is overwritten when it is reproduced, even if Matsushita was somehow combined with Yasukohchi, Applicants respectfully submit that the resulting combination would merely provide a recording/reproducing system that records data continuously while indiscriminately overwriting old data in the recording order (as taught by Yasukohchi), and overwrites stored data with "0" at the time of reproduction (as taught by Matsushita).

As such, even if these references were combined, the combination would not provide a

system which nullifies at least a part of a data block which is judged as needing to be nullified and at the same time records a new data block, as recited in claim 1.

Based on the foregoing, Applicants respectfully submit that the combination of Matsushita and Yasukohchi does not teach, suggest or otherwise render obvious all of the features recited in claim 1. Accordingly, Applicants submit that claim 1 is patentable over the cited prior art, an indication of which is kindly requested. Claims 2, 4-8 and 12-18 depend from claim 1 and are therefore considered patentable at least by virtue of their dependency.

Regarding claims 25 and 35, Applicants note that both of these claims recite the feature of writing, when a predetermined number of data blocks are judged as needing to be nullified or when one or more data blocks whose total amount of data reaches a predetermined amount are judged as needing to be nullified, the new data block to a recording area, on the recording medium, that stores a data block which is judged as needing to be nullified, to thereby nullify at least a part of the data block which is judged as needing to be nullified and at the same time record the new data block.

For at least similar reasons as discussed above with respect to claim 1, Applicants respectfully submit that the combination of Matsushita and Yasukohchi does not teach, suggest or otherwise render obvious at least the above-noted feature recited in claims 25 and 35. Accordingly, Applicants submit that claims 25 and 35 are patentable over the cited prior art, an indication of which is kindly requested. Claims 26-28 and 31-33 depend from claim 25, and claims 36 and 38 depend from claim 35. Accordingly, Applicants submit that these claims are patentable at least by virtue of their dependency .

B. The Examiner has rejected claims 9-11, 29, 30, 39 and 40 under 35 U.S.C. § 103(a) as being unpatentable over Matsushita in view of Yasukohchi, and further in view of Garfinkle (U.S. 5,400,402).

Claims 9-11 depend from claim 1; claims 29 and 30 depend from claim 25; and claims 39 and 40 depend from claim 35. Applicants respectfully submit that Garfinkle fails to cure the deficiencies of Matsushita and Yasukohchi, as discussed above, with respect to claims 1, 25 and 35. Accordingly, Applicants submit that claims 9-11, 29, 30, 39 and 40 are patentable at least by virtue of their dependency.

C. The Examiner has rejected claims 19-24, 34 and 44 under 35 U.S.C. § 103(a) as being unpatentable over Matsushita in view of Yasukohchi, and further in view of Masinter (U.S. 5,742,807).

Claims 19-24 depend from claim 1; claim 34 depends from claim 25; and claim 44 depends from claim 35. Applicants respectfully submit that Masinter fails to cure the deficiencies of Matsushita and Yasukohchi, as discussed above, with respect to claims 1, 25 and 35. Accordingly, Applicants submit that claims 19-24, 34 and 44 are patentable at least by virtue of their dependency.

VII. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited.

If any points remain in issue which the Examiner feels may best be resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,
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